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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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| 09/524,531 | 03/13/00 | IMHOF | B PM 264679 |

| EXAMINER | |
|---|---|
| CLEMENS, K | |
| ART UNIT | PAPER NUMBER |
| 1644 | 7 |

DATE MAILED: 04/18/01

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PILLSBURY MADISON & SUTRO LLP
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WASHINGTON DC 20005-3918

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trad marks**

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/524,531 | IMHOF ET AL. | |
| | Examiner | Art Unit | |
| | Karen Clemens | 1644 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *28 July 2000* .

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claims *1-19* are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved.

12)☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☒ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

15) ☐ Notice of References Cited (PTO-892)
16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
18) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
19) ☐ Notice of Informal Patent Application (PTO-152)
20) ☒ Other: *Notice to Comply with Sequence Rules* .

## *DETAILED ACTION*

### *Election/Restriction*

**1.** This application contains sequence disclosures in the specification and the claims that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 C.F.R. 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 C.F.R. 1.821 through 1.825 for the reason(s) set forth on the attached "Notice To Comply With Requirements For Patent Applications Containing Nucleotide And/Or Amino Acid Sequence Disclosures" and the Raw Sequence Listing Error Report.

Applicant's must provide a substitute computer disk, a substitute paper copy of the "Sequence Listing" as well as an amendment directing its entry into the specification and a statement that the content of the paper and computer readable copies are the same and, where applicable, include no new matter, as required by 37 C.F.R. 1.821(e), 1.821(f), 1.821(g), 1.825(b) or 1.821(d). Applicant is reminded to amend the specification to account for Sequences with 4 or more amino acids.

**2.** The following is noted:

The claims of Groups I-VI encompass separate and distinct products which include the CRAM-1 and CRAM-2 polypeptides, the encoding polynucleotides and antibodies specific for CRAM-1 and CRAM-2. The CRAM-1 and CRAM-2 polypeptides, the encoding polynucleotides and antibodies specific for CRAM-1 and CRAM-2 differ in structure and a person of ordinary skill in the art would not envision one in view of the other.

Therefore, the restriction has been set forth for as separate groups, irrespective of the format of the claims.

**3.** Restriction to one of the following inventions is required under 35 U.S.C. §121:

I. Claims 1-2 and 10-13, drawn to a CRAM-1 polypeptide, classified in Class 530, Subclass 350 and Class 424, subclass 185.1.

II. Claims 1-2 and 10-13, drawn to a CRAM-2 polypeptide, classified in Class 530, Subclass 350 and Class 424, Subclass 185.1.

III. Claims 3-9, drawn to CRAM-1 specific antibodies, classified in Class 530, Subclass 387.9 and Class 424, Subclass 139.1.

IV. Claims 3-9, drawn to CRAM-2 specific antibodies, classified in Class 530, Subclass 387.9 and Class 424, Subclass 139.1.

V. Claims 14-18, drawn to polynucleotides encoding CRAM-1, classified in Class 536, Subclass 23.5 and 24.2.

VI. Claims 14, 17 and 18, drawn to polynucleotides encoding CRAM-2, classified in Class 536, Subclass 23.5 and 24.2.

VII. Claim 19, drawn to a method for identification of differentially expressed DNA sequences, classified in Class 435, Subclass 6.

**4.** The inventions are distinct, each from the other because of the following reasons:

A. Groups I-VI are different products. They differ in structure and modes of operation and are therefore patentably distinct.

B. Groups I-VI and VII is are unrelated products and methods, respectively, and are therefore patentably distinct.

**5.** Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter and because a search of any of these distinct inventions would not be co-extensive with a search of the others, restriction for examination purposes as indicated is proper.

**6.** Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship

must be accompanied by a petition under 37 C.F.R. 1.48(b) and by the fee required under 37 C.F.R. 1.17(l).)

7. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen Clemens whose telephone number is (703) 308-8365. The examiner can normally be reached Monday through Friday from 8:00 AM to 5:00 PM. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 305-3014.

Karen Clemens, Ph.D.
Patent Examiner
Technology Center 1600
April 16, 2001

PHILLIP GAMBEL, PH.D
PRIMARY EXAMINER
TECH CENTER 1600
4/16/01

**Application No.: 09/ 524,531**

## NOTICE TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS CONTAINING NUCLEOTIDE SEQUENCE AND/OR AMINO ACID SEQUENCE DISCLOSURES

**The nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 C.F.R. 1.821 - 1.825 for the following reason(s):**

☑ 1. This application clearly fails to comply with the requirements of 37 C.F.R. 1.821-1.825. Applicant's attention is directed to these regulations, published at 1114 OG 29, May 15, 1990 and at 55 FR 18230, May 1, 1990.

☐ 2. This application does not contain, as a separate part of the disclosure on paper copy, a "Sequence Listing" as required by 37 C.F.R. 1.821(c).

☐ 3. A copy of the "Sequence Listing" in computer readable form has not been submitted as required by 37 C.F.R. 1.821(e).

☑ 4. A copy of the "Sequence Listing" in computer readable form has been submitted. However, the content of the computer readable form does not comply with the requirements of 37 C.F.R. 1.822 and/or 1.823, as indicated on the attached copy of the marked -up "Raw Sequence Listing."

☐ 5. The computer readable form that has been filed with this application has been found to be damaged and/or unreadable as indicated on the attached CRF Diskette Problem Report. A Substitute computer readable form must be submitted as required by 37 C.F.R. 1.825(d).

☐ 6. The paper copy of the "Sequence Listing" is not the same as the computer readable from of the "Sequence Listing" as required by 37 C.F.R. 1.821(e).

### Applicant Must Provide:

☑ An initial or substitute computer readable form (CRF) copy of the "Sequence Listing".

☑ An initial or substitute paper copy of the "Sequence Listing", as well as an amendment directing its entry into the specification.

☑ A statement that the content of the paper and computer readable copies are the same and, where applicable, include no new matter, as required by 37 C.F.R. 1.821(e) or 1.821(f) or 1.821(g) or1.825(b) or 1.825(d).

For questions regarding compliance to these requirements, please contact:
For Rules Interpretation, call (703) 308-4216
For CRF Submission Help, call (703) 308-4212
PatentIn Software Program Support (SIRA)
Technical Assistance.....703-287-0200
To Purchase PatentIn Software.....703-306-2600

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